

Filed September 13, 2006

1 Merits Panel
2 Mail Stop Interference
3 P.O. Box 1450
4 Alexandria VA 22313-1450
5 Tel: 571-272-9797
6 Fax: 571-273-0042
7

8 UNITED STATES PATENT AND TRADEMARK OFFICE
9 BEFORE THE BOARD OF PATENT APPEALS
10 AND INTERFERENCES
11 (Administrative Patent Judge Jameson Lee)
12

13
14
15 HAROLD R. GARNER
16 Junior Party
17 (Application 09/999,239),
18

19 v.
20

21 CALVIN F. QUATE
22 and
23 DAVID STERN
24 Senior Party
25 (Patent 6,271,957).
26 Patent Interference No. 105,445 (JL)
27 (Technology Center 1600)
28
29
30

31
32 Before SCHAFER, LEE, and MOORE, *Administrative Patent Judges*.
33

34 MOORE, *Administrative Patent Judge*.
35

36 **Decision on Order to Show Cause - Bd. R. 202(d)**

37 **A. Introduction**

38 1. Presently before the Board is a response (Paper 16) by Garner to an order to
39 show cause (Paper 3).

40 2. The order to show cause ordered Garner to explain why judgment should not
41 be entered against it based upon its failure to establish that it could prevail on the issue
42 of priority. 37 CFR § 41.202(d) (2005).

1 3. For the reasons which follow, we hold that Garner has not shown good cause
2 for admitting the evidence provided in its response to the order to show cause and
3 decline to admit it.

4 4. For the reasons which follow, we hold that Garner has not adequately
5 explained why judgment should not be entered against it based on its Bd. R. 202(d)
6 submissions to the examiner.

7 5. Accordingly, at this time it is appropriate to enter judgment against Garner.

8 B. Findings of Fact

9 1. This interference was declared July 20, 2006. (Paper 1).

10 2. Junior Party Garner, the applicant, provoked the interference. (Paper initially
11 submitted October 24, 2005 in Application 09/999,239).

12 3. The October 24, 2005 submission in Application 09/999,239 contained two
13 declarations, one by John Fondon dated October 20, 2005 (hereinafter Fondon I) and
14 one by Harold Garner dated November 28, 2001 (hereinafter Garner I).

15 4. Interferences are discretionary with the Director of the United States Patent
16 and Trademark Office. See, e.g. 35 U.S.C. §135(a)(“ Whenever an application is
17 made for a patent which, in the opinion of the Director, would interfere with any
18 pending application, or with any unexpired patent, an interference **may** be
19 declared. . . ”)(emphasis added).

20 5. The Director has set forth rules for the conduct of interferences. See, e.g. 37
21 CFR § 41 (2004)

1 6. To avoid potential harassment of patentees by applicants, one of the rules
2 imposed by the Director is 37 CFR § 41.202 (2004) which governs suggesting
3 interferences.

4 7. 37 CFR § 41.202 provides in pertinent part as follows:

5 § 41.202 Suggesting an interference.

6
7 (a) Applicant. An applicant, including a reissue applicant, may suggest an
8 interference with another application or a patent. The suggestion must:

9 ...
10 (4) Explain in detail why the applicant will prevail on priority,

11 ...
12 ...

13 (d) Requirement to show priority under 35 U.S.C. 102(g)

14 (1) When an applicant has an earliest constructive reduction to practice
15 that is later than the apparent earliest constructive reduction to practice for
16 a patent or published application claiming interfering subject matter, the
17 applicant must show why it would prevail on priority.

18 (2) If an applicant fails to show priority under paragraph (d)(1) of this
19 section, an administrative patent judge may nevertheless declare an
20 interference to place the applicant under an order to show cause why
21 judgment should not be entered against the applicant on priority. New
22 evidence in support of priority will not be admitted except on a showing of
23 good cause. The Board may authorize the filing of motions to redefine the
24 interfering subject matter or to change the benefit accorded to the parties.

25 (e) Sufficiency of showing.

26 (1) A showing of priority under this section is not sufficient unless it would,
27 if un rebutted, support a determination of priority in favor of the party
28 making the showing.

29 ...
30

31 8. The examiner in Application 09/999,239 advised Garner that the 37 CFR

32 § 1.131 submission was insufficient for a 37 CFR § 41.202. (Office Action,

33 December 23, 2005).
34
35
36
37

1 9. A second opportunity to comply with Bd. R. 202(d) was permitted by the
2 Examiner in Application 09/999,239 (Office Action December 23, 2005).

3 10. A second request was filed on January 26, 2006 in Application 09/999,239,
4 including a "Declaration Under 37 C.F.R. § 41.202(d)" with attachments (hereinafter
5 Garner II) and a second copy of the Fondon I declaration (Fondon II) and attachments.

6 11. The second request was substantively the same as the first request.

7 12. Simultaneous with the Declaration of this interference on July 20, 2006, the
8 Board placed the Applicant under an order to show cause (Paper 3)

9 13. The Board in paper 3 again determined that the totality of the showing
10 provided by Garner under 37 CFR § 41.202(d) from these three sources was
11 insufficient, if unrebutted, to support a determination of priority in favor of Garner.

12 14. Accordingly, Garner was ordered to show cause why judgment should not be
13 entered against it. (Paper 3).

14 15. Garner has responded with Paper 16.

15 16. Garner does not challenge the findings of the show cause order of Paper 3.

16 17. Instead, Garner appears to view the show cause order as an opportunity for
17 a third chance to put on a Bd. R. 202(d) showing.

18 18. Accompanying Paper 16 are three new declarations. They are the
19 Declaration of Harold Garner (hereinafter Garner III); the Declaration of John Fondon
20 (hereinafter Fondon III); and the Declaration of Robert Balog (hereinafter Balog I), each
21 with exhibits.

1 C. Discussion

2 i) The New Evidence

3 Bd. R. 202(d)(2) permits an administrative patent judge to declare an interference
4 to place an applicant under an order to show cause. Bd. R. 202(d)(2) expressly
5 provides that “[n]ew evidence in support of priority will not be admitted except on a
6 showing of good cause.”

7 Garner states that he is providing clearer copies of the exhibits, and thus “no new
8 evidence is proposed by this response” (Paper 16, page 1). Garner’s position in this
9 regard is factually and legally incorrect.

10 Evidence is “[a]ny species of proof, or probative matter, legally presented at the
11 trial of an issue, by the act of the parties and through the medium of witnesses, records,
12 documents, exhibits, concrete objects, etc., for the purpose of inducing belief in the
13 minds of the court or jury as to their contention.”¹

14 We find that the proffered new declaration testimony of the three witnesses is
15 new evidence, as are the new, clearer, exhibits. The Declaration of Robert Balog was
16 not previously supplied. It contains paragraphs 2 and 4 (there is no paragraph 3) which
17 make factual statements regarding the instrument of the attached exhibit. Those factual
18 statements by the witness are intended to persuade the Board that Garner would prevail
19 on priority. Consequently, they are new evidence.

¹ Black’s Law Dictionary, Fifth Edition, 1979, p.498.

1 The Fondon III declaration is different from the Fondon I and II declarations in
2 that additional factual information is added to paragraph 3, and an entirely new
3 paragraph 5 reciting facts regarding the functioning of an instrument has been added.
4 As these factual assertions by the witnesses are also intended to persuade the board
5 that Garner would prevail on priority, they are also new evidence.

6 The Garner III declaration is different from the Garner I and II declarations in that
7 Garner I and II contained only two passages of testimony (paragraphs 4 and 5) which
8 stated, without significant elaboration, that an attached photograph demonstrated that a
9 “device as claimed had been built and was operating prior to the filing date of the
10 reference cited as prior art in the parent application” (Paragraph 4) and that a mask
11 pattern had been created on a substrate (Paragraphs 4 and 5).

12 Garner III, on the other hand, now has 9 paragraphs of testimony regarding the
13 instrument, and the state of the art of light catalyzed chemistry. Again, these factual
14 assertions by the witness are also intended to persuade the Board that Garner would
15 prevail on priority, and are new evidence.

16 The determination whether a party seeking to initiate an interference has shown
17 ‘good cause’ for his failure to present the additional evidence at the time of his initial
18 submission is a matter within the discretion of the Board. *Huston v. Ladner*, 973 F.2d
19 1564, 1566, 23 USPQ2d 1910, 1912 (Fed. Cir. 1992) *citing Hahn v. Wong*, 892 F.2d
20 1028, 1034, 13 USPQ2d 1313, 1318 (Fed.Cir.1989).(discussing comparable prior Board
21 Rule 608).

1 Garner thus was required to show good cause why the evidence now submitted
2 was not earlier provided.

3 Returning to the perennial legal reference, "good cause" is:

4 Substantial reason, one that affords a legal excuse. Legally sufficient
5 ground or reason. Phrase "good cause" depends upon circumstances of
6 individual case, and finding of its existence lies largely in discretion of
7 officer or court to which discretion is committed. . . . "Good cause" is a
8 relative and highly abstract term, and its meaning must be determined not
9 only by verbal context of statute in which term is employed but also by
10 context of action and procedures involved in type of case presented.²
11

12 Good cause, in terms of a prior Rule 608 showing in an interference, has been
13 described as including, *inter alia*, a reason why the evidence was not available and
14 could not have been presented with the motion or any other valid reason. Excluded
15 from good cause is attorney conduct. See, e.g. *Huston* 973 F.2d at 1566, 23 USPQ2d at
16 1912-1913; Notice of Final Rule, Patent Interference Proceeding, 49 Fed.Reg. 48416,
17 48423 (Dec. 12, 1984). Bd. R. 202(d) has the same "good cause" requirement.

18 The proof standards applicable to situations such as this one are discussed in
19 *Basmadjian v. Landry*, 54 USPQ2d 1617 (Bd. Pat. App. & Int. 1997) .

20 In the present instance, no reason is offered for the late presentation of the
21 evidence in the three later submitted declarations. As a consequence, we conclude that
22 Garner has not shown good cause why the evidence should be admitted. Accordingly,
23 the three declarations and their associated exhibits shall not be admitted.

24 We now turn to a substantive analysis of the evidence which is of record.

² Black's, *Id.* p. 623

1 ii. The Sufficiency Of the Showings

2 *a) Round 1 – October, 24, 2005*

3 The Applicant was aware that it needed to comply with the requirements of Bd.
4 R. 202 at the time of this submission (Page 7 and 8). Indeed, the applicant observed
5 that the requirement was similar to prior Bd. R. 608 which required the applicant to
6 make a prima facie case of why it will prevail on priority (Page 8, lines 7-9).

7 Garner's earliest apparent constructive reduction to practice date is June 4,
8 1998, which is after Quate's apparent constructive reduction to practice date of May 29,
9 1998. Garner was therefore required to present evidence sufficient to prove a date of
10 invention of the subject matter of the proposed count before May 29, 1998. Garner's
11 evidence must have been sufficient to support a determination of priority in his favor. 37
12 CFR § 41.202(e).

13 "[P]riority of invention goes to the first party to reduce an invention to practice
14 unless the other party can show that it was the first to conceive of the invention and that
15 it exercised reasonable diligence in later reducing that invention to practice." *Medichem*
16 *S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1169, 77 USPQ2d 1865, 1873 (Fed. Cir. 2006)
17 quoting *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir.
18 1998).

19 Garner's first attempt to meet Bd. R. 202(d) asserts only an earlier actual
20 reduction to practice. It is unnecessary, therefore, to consider conception and diligence.

21 "In order to establish an actual reduction to practice, the inventor must prove
22 that: (1) he constructed an embodiment or performed a process that met all the

1 limitations of the interference count; and (2) he determined that the invention would
2 work for its intended purpose.” *Taskett v. Dentlinger*, 344 F.3d 1337, 1340, 68 USPQ2d
3 1472, 1474 (Fed.Cir. 2003) quoting *Cooper*, 154 F.3d at 1327, 47 USPQ2d at 1901.

4 In addition, an inventor’s testimony as to the facts of the invention must be
5 corroborated by independent evidence. *Cooper*, 154 F.3d at 1330, 47 USPQ2d 1896 at
6 1903 (“In order to establish an actual reduction to practice, an inventor’s testimony must
7 be corroborated by independent evidence.”); *Hahn v. Wong*, 892 F.2d at 1032-33, 13
8 USPQ2d at 1317 (Fed. Cir. 1989); *Reese v. Hurst*, 661 F.2d 1222, 1225, 211 USPQ
9 936, 940 (CCPA 1981).

10 When considering the sufficiency of corroborating evidence a reasonableness
11 standard is used. *Scott v. Finney*, 34 F.3d 1058, 1061-62, 32 USPQ2d 1115, 1118 (Fed.
12 Cir. 1994); *Holmwood v. Sugavanam*, 948 F.2d 1236, 1238, 20 USPQ2d 1712, 1714
13 (Fed. Cir. 1991). Whether a putative inventor’s testimony has been sufficiently
14 corroborated is determined by a “rule of reason” analysis, in which “an evaluation of all
15 pertinent evidence must be made so that a sound determination of the credibility of the
16 inventor’s story may be reached.” *Price v. Symsek*, 988 F.2d 1187, 1195, 26 USPQ2d
17 1031, 1037 (Fed. Cir. 1993). However, that “rule of reason” analysis does not alter the
18 requirement of independent corroboration of an inventor’s testimony. *Brown v.*
19 *Barbacid*, 276 F.3d 1327, 1335, 61 USPQ2d 1236, 1240 (Fed. Cir. 2002). The inventive
20 facts must not rest alone on testimonial evidence from the inventor himself. *Brown*, 276
21 F.3d at 1335, 61 USPQ2d at 1240; *Cooper*, 154 F.3d at 1330, 47 USPQ2d at 1903.

1 The evidence submitted with this first suggestion of an interference included two
2 declarations filed in support of the request, each including attachments. One is Garner I
3 and the second is Fondon I.

4 In requesting an interference Garner suggested a count as required by 37 CFR §
5 41.202(a):

6 A method of patterning on a substrate comprising the steps of: generating a light beam;
7 illuminating a micromirror with said light beam; redirecting said light beam with said
8 micromirror onto said substrate; and catalyzing a light sensitive reaction proximate to
9 the surface of said substrate using said redirected light beam in a predetermined
10 pattern." (Application 09/999,239, Paper filed October 24, 2005, p. 7.)
11

12 Thus, Garner needed to prove, with reasonable corroboration, that he
13 constructed an embodiment or performed a process that met all the limitations of the
14 interference count; and he determined that the invention would work for its intended
15 purpose.

16 Garner's first request for an interference argued that the declarations showed
17 that Garner had actually reduced the invention of the count to practice before the
18 effective filing date of the application that issued as the Quate patent and was,
19 therefore, prima facie entitled to priority. Application 09/999,239, Remarks dated
20 October 24, 2005, p. 7-8.

21 Garner's complete testimony on the reduction to practice of the subject matter of
22 the proposed count is reproduced below:

23 4. To establish the date of completion of the invention of this
24 application, the following copies of a presentation related to a grant
25 application is attached hereto as Exhibit A and submitted as evidence.
26 The photograph in Exhibit A was taken in August 1997 and demonstrates
27 that the device as claimed had been built and was operating prior to the

1 filing date of the reference cited as prior art in the parent application of this
2 filing. Exhibit A, attached hereto demonstrates that the device as claimed
3 had been not only conceived but reduced to practice before the filing date
4 of the art cited in the parent application. Furthermore, this affidavit in
5 conjunction with the affidavit 37 C.F.R. §1.131 filed in the parent
6 application demonstrated that the device was used to form a mask pattern
7 formed and printed using the present device, and was therefore reduce to
8 practice in the United States prior to the filing date of the art used for the
9 rejection.

10
11 5. From the lab notebook pages attached hereto as Exhibit A, it can
12 be seen that the invention in this application was used to produce a mask
13 pattern on a substrate on the date even therewith, which is on or before
14 February 23, 1998, which is a date earlier than the effective date of the
15 reference cited in the parent application. (Garner I, pp. 1-2.)
16

17 Garner I also refers to and relies upon a declaration filed "in the parent case,"
18 Application 09/326,526. That declaration states that the laboratory notebook pages
19 attached to the declaration show that "invention in the application" was used to produce
20 a mask pattern on a substrate on or before February 23, 1998. Application 09/326,526,
21 Declaration filed March 1, 2001, pp. 1-2.(hereinafter Garner 0)

22 Garner's complete testimony relating to the date of the invention from Garner 0 is
23 as follows:

24 4. To establish the date of completion of the invention of this
25 application, the following copies of lab notebook pages are attached
26 hereto as Exhibit A and submitted as evidence.
27

28 5. From the lab notebook pages attached hereto as Exhibit A, it can
29 be seen that the invention in this application was used to produce a mask
30 pattern on a substrate on the date even therewith, which is on or before
31 February 23, 1998, which is a date earlier than the effective date of the
32 reference. (Application 09/326,526, Declaration filed March 1, 2001, pp.
33 1-2.)
34

1 Fondon I was submitted for the purpose of corroborating Garner's testimony.
2 (Application 09/999,239, Remarks dated October 24, 2005, pp. 8-9.) Fondon testifies
3 that he saw a prototype of a digital optical chemistry micromirror imager built in
4 November 1997 and that the copy of the photograph attached to his declaration shows
5 the device he saw at that time. Application 09/999,239, Declaration filed October 24,
6 2005, p. 1. The photograph appears to be identical to one of the photographs attached
7 to Garner 0 and Garner I.

8 In evaluating a priority showing under § 41.202(d) we look to the count proposed
9 by the applicant pursuant to § 41.202(a)(2).

10 The count is directed to a method for forming a pattern on a substrate requiring the
11 following steps:

- 12 1. Generating a light beam;
- 13 2. Illuminating a micromirror with said light beam;
- 14 3. Redirecting said light beam with said micromirror onto said substrate; and
- 15 4. Catalyzing a light sensitive reaction proximate to the surface of said substrate
16 using the redirected light beam in a predetermined pattern. (Application 09/999,239,
17 Paper filed October 24, 2005, p. 7.)

18 To show priority, Garner had to prove, with corroborated evidence, that each of
19 the above steps was performed and resulted in the formation of a predetermined pattern
20 on a substrate. Garner 0, Garner I, and Fondon I, and the attachments submitted
21 with the declarations, do not show that the specific process of the proposed count was
22 carried out and worked for its intended purpose.

1 Garner testified that the device shown in the copy of the photograph in "Exhibit A"
2 was built and operating in August 1997. Garner 0, Garner I, pp. 1-2. Garner does not
3 testify in either declaration as to the specific steps that were carried out during the
4 operation. The photograph of the device did not show the process steps that the device
5 carried out. Consequently, Garner did not provide sufficient evidence to carry its
6 burden of proof that the steps of the count were performed by the machine depicted in
7 the photographs.

8 Garner also testified that the lab notebook pages show that the invention in the
9 application was used to produce a mask pattern on a substrate before February 23,
10 1998. Garner I, pp. 1-2. However, Garner did not explain the content of the notebook
11 pages and how those pages demonstrate that the process steps of the proposed count
12 were carried out and the formation of a predetermined pattern on a substrate was
13 achieved. Nor did Garner explain how the content of the notebook pages related to the
14 device purportedly shown in the photograph.

15 From a review of the submitted notebook pages, the steps of illuminating a
16 micromirror, redirecting the light beam with the micromirror onto a substrate, and
17 catalyzing a light sensitive reaction proximate the surface of the substrate in a
18 predetermined pattern are not apparent.

19 We observe that one of the notebook pages includes the word "mask" and an
20 arrow pointing to a region on the page in Garner I or Garner 0. A cross-type pattern is
21 visible, but it is imperfect in that there is still visible patterning within the cross. In any
22 event, Garner has not explained what is shown by the "mask" and how it demonstrates

1 that a reaction was catalyzed proximate to the surface of a substrate in a predetermined
2 pattern.

3 Thus, we conclude that Garner's declarations 0 and I, and the attached copies of
4 the photographs and notebook pages do not prove that the process of the proposed
5 count was actually reduced to practice.

6 The Fondon declaration similarly fails to establish that the process of the
7 proposed count was actually reduced to practice. Fondon's declaration refers to a copy
8 of a photograph that is said to show a prototype of a digital optical chemistry micromirror
9 imager. Fondon I, p. 1. The copy of the photograph appears to be the same as on of
10 the copies attached to Garner's declarations. Fondon does not testify how the
11 photograph demonstrates an actual reduction to practice of each element of the process
12 of Garner's proposed count. Fondon, while testifying that he saw the device shown in
13 the photograph in Garner's laboratory in November 1997, does not testify that the
14 device was used to carry out the process steps required by the proposed count and
15 produced a predetermined pattern on a substrate.

16 At best, the Fondon declaration corroborates the existence of the device
17 purportedly shown in the photographs. However, it does not prove or corroborate that
18 the process of the proposed count was performed and worked for its intended purpose.
19 The Fondon declaration, like Garner's, fails to establish that the process of the count
20 was actually reduced to practice.

21 Garner 0 relies on the copies of the same photographs and notebook pages as
22 the later declarations. Garner 0, pp. 1-2. However, Garner 0 is less informative than

1 any of Garner I or II. Garner 0 does not establish that the steps expressly stated in
2 Garner's proposed count were carried out and that a pattern was formed on a substrate.
3 Again, neither the content of the photographs nor the laboratory notebook pages are
4 sufficiently explained in the Garner 0 declaration.

5 Garner's counsel attempted to explain how the Garner 0, Garner I, and Fondon I
6 declarations and attachments demonstrate an actual reduction to practice of the
7 process of the proposed count. Application 09/999,239, Remarks dated October 24,
8 2005, p. 8. Counsel's explanation is only attorney argument, not supported by Garner's
9 and Fondon's testimony. Garner 0, Garner I, and Fondon I are much less detailed than
10 argued by his counsel. Garner testifies only "that the device as claimed" (emphasis
11 added) was reduced to practice and that "the invention in this application" was used to
12 make a mask. Neither the device nor the "the invention" are explained. None of the
13 testimony provides a basis for the specific argument as to the process steps and results
14 urged by counsel.

15 Counsel's argument cannot take the place of evidence lacking in the record.
16 *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed.
17 Cir. 1997). Garner's counsel's statements are effectively unsworn testimony rather than
18 argument. Counsel's argument has been given no evidentiary weight.

19 Garner's attachments to the declarations of record have been carefully reviewed.
20 However, absent testimony explaining how the copies of the photographs and notebook
21 pages show that all the elements of the proposed count were actually performed and
22 achieved the desired result, Garner's evidence submitted October 24, 2005 fails to

1 establish an actual reduction to practice and fails to prove that he has a basis to prevail
2 on priority. 37 CFR § 41.202(e).

3 *b) Round 2 – January 26, 2006*

4 The examiner, in an action dated December 23, 2005, determined that the Rule
5 131 declaration was insufficient. The examiner required a Bd. R. 202(d)(2) declaration.

6 The Official communication warned Garner that its Rule 131 affidavit was
7 insufficient and it needed to comply with Board Rule 202(d). Rule 202(d) expressly
8 requires the applicant to show why it would prevail on priority.

9 On January 26, 2006 Garner filed what it called a substitute declaration. Garner
10 admitted in its transmittal letter that “[t]he content of the declaration is unchanged.” We
11 note that Fondon II is identical to Fondon I and Garner II differs from Garner I only in
12 that it is later executed and bears a different title. No substantive changes were made
13 to Garner II.

14 We observe that Garner was given a second opportunity to comply with Bd. R.
15 202(d) and that it did not avail itself of the opportunity.

16 For the reasons discussed above, the combined evidence of Garner II and
17 Fondon II again failed to establish why Garner would prevail on priority.

18 *c) Round 3 – August 8, 2006*

19 The entirety of Garner’s Response to the show cause order discusses the newly
20 submitted affidavit testimony and what the new evidence shows. However, we have
21 found that Garner did not show good cause for admitting the evidence. Consequently,
22 the response fails to convince us that judgment should not be entered against Garner.

1 In several locations, the Response indicates that the revised declarations are “as
2 suggested in the Order to Show Cause” (Paper 16, page 2, line 10) and the newly filed
3 evidence “tracks the requirements of the Order to Show Cause” (*Id.*, page 3, line 11).
4 These statements mischaracterize the Order to Show Cause. The Order to Show
5 Cause (Paper 3) was describing the requirements of Bd.R. 202(d) (Page 1, line 7), not
6 inviting the Applicant for a third bite at the apple. A show cause order is an order to an
7 entity to appear by response and explain why the Board should not take a proposed
8 action (i.e. enter judgment).³ It is not an invitation to submit new evidence unless the
9 Board expressly states new evidence will be permitted. The Board did not authorize the
10 submission of new evidence in the Order to Show Cause.

11 Garner should have either (1) explained why its previous submissions were
12 sufficient to show why it would prevail on priority, or (2) shown good cause why new
13 evidence should be admitted. Garner did neither.

14 D. Conclusion

15 As Garner has failed to show cause why judgment should not be entered against
16 it, judgment is entered against Garner in a separate paper filed today.

³ See, e.g. *Black's, Id.*, page 1237.

1	/Richard E. Schafer/)	
2	ADMINISTRATIVE PATENT JUDGE)	
3)	
4)	BOARD OF PATENT
5	/Jameson Lee/)	APPEALS AND
6	ADMINISTRATIVE PATENT JUDGE)	INTERFERENCES
7)	
8)	
9	/James T. Moore/)	
10	ADMINISTRATIVE PATENT JUDGE)	

1
2
3 VIA EMAIL:

4
5 Attorney for Garner:

6
7 Bennett J. Berson
8 Nicholas J. Seay
9 QUARLES & BRADY LLP
10 1 South Pinckney Street
11 Suite 600
12 Madison, WI 53703

13
14 Tel: 608-251-5000
15 Fax: 608-251-9166

16
17 bjb@quarles.com
18 njs@quarles.com
19

20
21 Attorney for Quate:

22
23 Oliver Ashe
24 Jill M. Browning
25 Thomas Malone
26 Greenblum & Bernstein, P.L.C.
27 1950 Roland Clarke Place
28 Reston, VA 20191

29
30 Tel: 703-716-1191

31
32 oashe@gbpatent.com
33 jbrowning@gbpatent.com
34 Thomas_Malone@Affymetrix.com
35